

REMARKS

The Non-Final Office Action dated September 17, 2008 has been received and carefully considered. Claims 1-69 are pending in the application. Claims 1-69 stand rejected. No new matter has been added. Entry of the amendments to the claims and reconsideration of the outstanding rejections in the present application are requested based on the following remarks¹.

Claim Numbering

Applicant appreciates the Examiner's correction of the claim number. The claim listing included above reflects the renumbering.

Rejection of Claims 1-24 under 35 U.S.C. § 112, ¶2

Claims 1-24 are rejected under §112, ¶2 as being indefinite. Applicant has amended claims accordingly to address this rejection. Applicant submits that the amendments to the claims overcome this rejection and requests the §112, ¶2 rejections be withdrawn.

Rejection of Claims 1-17, 24-25, 28-38, 44-50, 54-63, and 65-69 under 35 U.S.C. § 102(e)

Claims 1-17, 24-25, 28-38, 44-50, 54-63, and 65-69 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,138,106 ("Walker"). This rejection is hereby respectfully traversed.

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

In order to maintain an anticipatory rejection under 35 U.S.C. §102, a reference must teach each and every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” MPEP § 2131 (quoting Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The Federal Circuit recently reiterated the standard for anticipation under 35 U.S.C. §102 in Net Moneyin v. Verisign, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008), stating:

We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Independent claim 1 is set forth above. Claim 1 recites the element of “wherein the database stores ones of the uniquely identifying codes that have been previously received from one or more user stations.” The Examiner alleges that the “item code field 62” of Walker reads on the *uniquely identifying codes* of the claimed inventions. Walker discloses that the item code field 62 is contained in the “product database 28.” Col. 5, lines 9-11; Fig. 4. However, the item code field 62 is stored in the product database 28; it is not *previously received* from the one or more user stations.

Walker discloses “the memory stores a plurality of product codes for identifying products.” Col. 2, lines 44-45. Walker further discloses “[t]he processor receives data identifying a first product code from the first subset of product codes.” Col. 2, lines 51-53. This disclosure of Walker fails to indicate where the processor receives the data from and it fails to disclose that the memory *stores* the first product code. Applicant submits that the product codes

are already stored in the memory of Walker and first product code is used for identification of the product. Therefore, Walker fails to anticipate this element of the claimed inventions.

Claim 1 further recites the element of “wherein the database server credits an account of a user associated with the given user station with a non-zero valuation credit only if such new candidate code received from the given user station was not previously stored in the database.” The Examiner alleges, on page 4 of the Office Action, that Walker discloses this element. Specifically, the Examiner alleges that Walker’s disclosure of “[t]he processor further operates to reduce the initial value by the product price of the first product code to provide a first adjusted value” (col. 3, lines 8-10) anticipates the recited element of the claimed inventions. The Examiner alleges that reduce the initial value reads on *non-zero valuation credit*. Applicant disagrees. The claim recites the action of credit to an account with *a non-zero valuation credit*. Applicant submits that this is a different action from Walker’s reducing an initial value of the product price. Walker therefore fails to disclose the claimed inventions with the same elements arranged or combined as recited and hence, Walker fails to anticipate the elements of independent claim 1.

Rejected claims 2-17 and 24 depend from independent claim 1 and thus incorporate the elements of independent claim 1, and are allowable for at least the reasons set forth above. Moreover, these claims recite additional features that are not disclosed or suggested by the cited reference.

Independent claims 25, 44, 50, 59, and 60, though different in scope, recite similar elements to independent claim 1, and are therefore allowable for at least the reasons given for independent claim 1 above. Dependent claims 28-38, 44-49, and 54-58 depend from

independent claims 25, 44, and 50, and thus incorporate all the elements of the respective independent claims and are therefore allowable for at least the reasons set forth above.

Independent claim 61 is set forth above. The Examiner has failed to provide a specific basis for the rejection of claim 61. Indeed, the Examiner has lumped claim 61 with the other independent claims discussed above. However, Applicant submits that claim 61 recites distinct elements from the other independent claims. Therefore, the Examiner has failed to address the elements of claim 61 and therefore the Office Action is incomplete. See MPEP § 707.07(g) (prohibiting “piecemeal” examination). Applicant objects to the Examiner’s rejections under 35 U.S.C. §102 to the extent they fail to accurately specify or identify the portions or features of Walker that purportedly anticipate the pending claim limitations. Accordingly, Applicant is forced to speculate and is unable to properly respond to the Examiner’s contentions. Applicant requests, therefore, that the anticipation rejection be withdrawn for independent claim 61 and its dependent claims, 62 and 65-69. See e.g., Ex parte Gambogi, 62 U.S.P.Q.2d 1209, 1212 (Bd. Pat. App & Interf. 2001) (“Rejection of claims in patent application...must be vacated and remanded, since patent examiner...has not referred to specific portions of...cited [reference], and since rejection therefore requires both applicants and Board of Patent Appeals and Interferences to speculate....”).

This is particularly true here, where the dependent and independent claims recite features and structures that go above and beyond the structure recited in independent claim 1, for example, and such features cannot be dismissed as being minor technical differences. Nevertheless, rather than waiting for the Office to allege specific grounds for rejecting claim 61, Applicant has taken the initiative to provide an examples explaining how the applied prior art fails to anticipate claim 61. The Applicant reserves the right to expand upon and/or revise these

arguments, if warranted by future Office Actions. Furthermore, the Applicant's lack of discussion with respect to any claim or claim element is not to be taken as an admission that the Office Action has set forth a rejection of that claim, or that the Applicant concedes that any such rejection is proper.

Independent claim 61 recites the element of "wherein said at least one product is transacted in exchange for multiple resource types included in said account." Walker discloses the use of "gift certificates, purchasable by a buyer, represent a value stored in a database." Abstract. Applicant submits that Walker's stored value gift certificates do not represent *multiple resource types included in said account* as defined by the claimed inventions. Therefore, Walker fails to anticipate claim 61, for at least this reason, and Applicant respectfully requests the withdrawal of the anticipation rejection of independent claim 61.

Dependent claims 65-69 depend from independent claim 61, and is allowable for at least the reason set forth above.

Rejection of Claims 18-22, 26-27, 39-42, 51-53, and 64 under 35 U.S.C. 103(a)

Claims 18-22, 26-27, 39-42, 51-53, and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Official Notice. Applicant respectfully traverses these rejections.

Claims 18-22, 26-27, 39-42, 51-53, and 64 are dependent upon independent claims 1, 25, 44, 50, and 61, and thus inherently incorporate all of the limitations of the independent claims. Also, the secondary reference (i.e., Official Notice) fails to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1, 25, 44, 50, and 61. Accordingly, claims 18-22, 26-27, 39-42, 51-53, and 64 are allowable over

the combination of the secondary reference with the primary reference at least by virtue of their dependency on independent claims 1, 25, 44, 50, and 61.

As stated in MPEP § 2144.03, Official Notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances and should be "judiciously applied". The notice of facts beyond record must be "capable of such instant and unquestionable demonstration as to defy dispute." See MPEP § 2144.03. If the Applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained. MPEP § 2144.03(C).

Applicant respectfully traverses the Examiner's reliance upon Official Notice and request the Examiner provide documentary evidence supporting the assertions thereof. Specifically, the Examiner alleges that it is old and well known to have a code reader for tracking asset and inventory. Claims 19 and 39 recite the element of "wherein the new candidate code is read by a code reader at the user station." Applicant submits that having a code reader *at the user station* is not old and well known, at the time of filing of the application. The Examiner's allegation of Official Notice is based on hindsight from reading the present claims. Therefore, Applicant traverses this reliance on Official Notice and requests documentary evidence thereof.

The Examiner alleges that is well known to add sellers to the certificate as a customer of the product of the manufacturer because a seller of the gift certificate is allowing its customer to buy a manufacturer's product and to give flexible process for the redeemer. Applicant submits that it is not common practice for a seller of a certificate, such as a *retailer*, to be a *user* of said certificate. Why would having the seller added to the certificate as a customer of the product give flexible process for the redeemer? A seller typically allows a customer to buy a manufacturer's product. The redeemer of the certificate typically is the customer, so having the

seller added to the certificate fails to provide any flexibility for the redeemer. A customer typically purchases a certificate from a seller. The customer may then either use the certificate themselves or convey to another customer to use the certificate. Therefore, Applicant traverses this reliance on Official Notice and requests documentary evidence thereof.

Claims 26 and 51 recite the element of “wherein the user is a retailer.” Claim 64 recites the element of “wherein said at least one front-end service includes at least one of merchants, financial resources, service providers, and business partners.” Applicant submits that the Examiner’s rejection is only for claims 26 and 51 (“but Walker does not explicitly teaches [sic] that the user may be a retailer.”). The elements of claim 64, as recited above, are different. Therefore, the Office Action has failed to provide a specific rejection basis for claim 64.

Rejection of Claims 23 and 43 under 35 U.S.C. 103(a)

Claims 23 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of U.S. Patent No. 6,321,211 (“Dodd”). Applicant respectfully traverses these rejections.

Claims 23 and 43 are dependent upon independent claims 1 and 25, respectively, and thus inherently incorporate all of the limitations of the independent claims. Also, the secondary reference (i.e., Dodd) fails to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1 and 25. Accordingly, claims 23 and 43 are allowable over the combination of the secondary reference with the primary reference at least by virtue of their dependency on independent claims 1 and 25.

CONCLUSION

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Amendment. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. §1.17, and all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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